

REMARKS

In the Official Action dated April 18, 2005, the Examiner objected to claim 3, alleging that claim 3 should be amended to proper alternative claim language format (i.e., “selected from the group consisting of A, B, ..., and X.”). The Examiner objected to claim 24, alleging that claim 24 recited the limitation “the method of claim 29.” The Examiner rejected Claims 6-7 under 35 U.S.C. §112, second paragraph, alleging that these claims are indefinite. The Examiner rejected claims 1-3, 6-7, 10-11, 13-17 and 22-24 under 35 U.S.C. §102(b), alleging that these claims are anticipated by Lear et al. The Examiner rejected claims 4-5 and 21 under 35 U.S.C. §103(a), alleging these claims are unpatentable over Lear et al. in view of Shunichi et al. The Examiner rejected claims 8-9 and 18 under 35 U.S.C. §103(a), alleging these claims are unpatentable over Lear et al. in view of Mayer et al. The Examiner rejected claim 19 under 35 U.S.C. §103(a), alleging these claims are unpatentable over Lear et al. in view of Nanishi et al.

This response addresses each of the Examiner’s objections and rejections. Accordingly, the present application is in condition for allowance. Favorable consideration of all pending claims is therefore respectfully requested.

The Applicants have amended the specification and claims to replace the term “silicone monomer” with the term “siloxane monomer” to more properly describe the general formula depicted in original claim 12 and the specification.

Applicants have amended claim 1 without prejudice by deleting the subject matter therein being drawn to a non-elected invention. In addition, claims 12 and 20 have been cancelled without prejudice as being drawn to a non-elected invention. Applicants reserve the right to file continuing applications directed toward the deleted subject matter.

The Examiner objected to claim 3, alleging that claim 3 should be amended to proper

alternative claim language format (i.e., “selected from the group consisting of A, B, . . . , and X.”). For purposes of expediting prosecution, Applicants have amended claim 3 to include proper Markush Language for claim 3. Accordingly, applicants request reconsideration and withdrawal of this rejection.

The Examiner objected to claim 24, alleging that claim 24 recited the limitation “the method of claim 29.” For purposes of expediting prosecution, Applicants have amended claim 24 to be dependant on claim 23. Accordingly, applicants request reconsideration and withdrawal of this rejection.

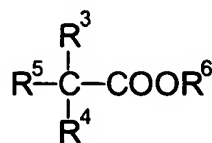
The Examiner rejected Claims 6-7 under 35 U.S.C. §112, second paragraph, alleging that these claims are indefinite. Specifically, the Examiner has alleged that there is insufficient antecedent basis for the phrase “the composition of claim 1 wherein.” In response, Applicants have amended claim 6 by inserting the phrase “said acrylate monomer has the following general formula:” after the phrase “the composition of claim 1 wherein.” Accordingly, the term of the acrylate monomer in Claim 7 now has antecedent basis. Applicants respectfully request reconsideration and removal of this rejection under 35 U.S.C. §112, second paragraph.

The Examiner rejected claims 1-3, 6-7, 10-11, 13-17 and 22-24 under 35 U.S.C. §102(b), alleging that these claims are anticipated by Lear et al. Specifically, the Examiner alleges that Lear et al. discloses component (a) “acrylate monomer” in column 5, lines 8-10; component (b) “a tertiary carboxylic ester” in column 4, lines 31-32; and component (c) “a fluoro acrylate monomer” in column 5, lines 28-29. Applicants respectfully traverse.

There are many differences between the present invention and the teachings of the prior art. Lear et al. fail to disclose a resin composition comprising a polymer and a solvent, characterized in that said polymer is obtained by polymerizing (a) an acrylate monomer;

(b) a tertiary carboxylic ester; and (c) a fluoro acrylate monomer.

For example, Lear et al. do not disclose element (b) of claim 1, which is a tertiary carboxylic ester having the following general formula:



wherein R³, R⁴, R⁵ and R⁶ are as defined in claim 1.

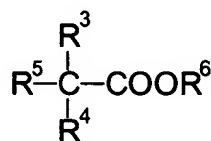
In Lear et al. the tertiary moiety is on the alcohol portion of the ester rather than on the carboxylic acid portion of the ester.

Because Lear et al. fail to disclose each and every element of claim 1 of the present invention, claim 1 and dependent claims 2-3, 6-7, 10-11, 13-17 and 22-24 are novel over Lear et al. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection under 35 U.S.C. §102(b).

The Examiner rejected claims 4-5 and 21 under 35 U.S.C. §103(a), alleging these claims are unpatentable over Lear et al. in view of Shunichi et al. Applicants respectfully traverse.

As discussed above, Lear et al. fail to disclose a resin composition comprising a polymer and a solvent, characterized in that said polymer is obtained by polymerizing (a) an acrylate monomer; (b) a tertiary carboxylic ester; and (c) a monomer selected from the group consisting of a fluoro acrylate monomer, a silicone monomer, and a mixture thereof. More specifically, Lear et al. do not disclose component (a) an acrylate monomer being copolymerized with a tertiary carboxylic acid and component (c). Instead, Lear et al. disclose the acrylic acid monomer is copolymerized with a compound of formula I, II, or III, and this polymerized product is more complex than the acrylic acid monomer. This product in Lear et al. results from a

copolymer with a second component, which second component is quite different from the tertiary carboxylic acid ester of the present invention. Even if the third component is the same in both, it is apparent that the polymerized products of Lear et al. and of the present invention are structurally quite different. Moreover, Lear et al. do not disclose element (b) of claim 1, which is a tertiary carboxylic ester having the following general formula:



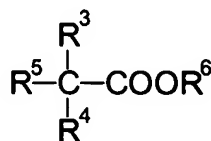
wherein R³, R⁴, R⁵ and R⁶ are as defined in claim 1. In addition, Lear et al. do not suggest or disclose making the necessary modifications in order to arrive at the resin composition of the claimed invention. Furthermore, Lear et al. do not motivate the skilled artisan to combine a) an acrylate monomer; (b) a tertiary carboxylic ester; and (c) a monomer selected from the group consisting of a fluoro acrylate monomer, a silicone monomer, and a mixture thereof.

In addition, Shunichi et al. do not correct the deficiencies of Lear et al. Shunichi et al. disclose a copolymer consisting of a perfluoroalkylolefin monomer unit, a hydroxyl group-containing vinyl based monomer unit, and another vinyl-based monomer unit. The combination of components in Schunichi et al. is not related and is not the same as the components of the claimed invention. Furthermore, Schunichi et al. do not motivate one skilled in the art to combine its teachings with Lear et al. in order to make the necessary modifications to arrive at the claimed invention. Moreover, every combined combination would not suggest the present invention. Accordingly, Lear et al. do not render the claimed invention obvious in view of Shunichi et al.

Because not each and every element of the claimed invention is either disclosed or suggested in Shunichi et al. in view of Lear et al., the Examiner has failed to set forth a *prima facie* case of obviousness. In addition, because Schunichi et al. do not motivate one skilled in the art to combine its teachings with Lear et al. in order to make the necessary modifications to arrive at the claimed invention, the Examiner has failed to set forth a *prima facie* case of obviousness. Accordingly, Applicants respectfully request reconsideration and removal of this rejection under 35 U.S.C. §103(a).

The Examiner rejected claims 8-9 and 18 under 35 U.S.C. §103(a), alleging these claims are unpatentable over Lear et al. in view of Mayer et al. Applicants respectfully traverse.

Applicants reiterate the arguments of Lear et al. hereinabove. As discussed above, Lear et al. fail to disclose a resin composition comprising a polymer and a solvent, characterized in that said polymer is obtained by polymerizing (a) an acrylate monomer; (b) a tertiary carboxylic ester; and (c) a monomer selected from the group consisting of a fluoro acrylate monomer, a silicone monomer, and a mixture thereof. More specifically, Lear et al. do not disclose component (a) an acrylate monomer being polymerized with a tertiary carboxylic ester. Moreover, Lear et al. do not disclose element (b) of claim 1, which is a tertiary carboxylic ester having the following general formula:



wherein R³, R⁴, R⁵ and R⁶ are as defined in claim 1. Lear et al. do not suggest or disclose making the necessary modifications in order to arrive at the resin composition of the claimed

invention. Furthermore, Lear et al. do not motivate the skilled artisan to combine a) an acrylate monomer; (b) a tertiary carboxylic ester; and (c) a monomer selected from the group consisting of a fluoro acrylate monomer, a silicone monomer, and a mixture thereof.

Mayer et al. do not correct the deficiencies of Lear et al. Mayer et al. disclose a three component composition comprising (I) a binder comprising at least one acrylate copolymer dissolved or dispersed in organic solvent; (II) at least one nonblocked polyisocyanate as a crosslinking agent; and (III) an essentially binder free water containing component. The combination of components in Mayer et al. are not related and are not the same as the components of the claimed invention. There is no teaching that the other two components of Mayer et al. are equivalent to the other two components of Lear et al. It is respectfully submitted that the Examiner is culling and choosing elements in Mayer et al. that are not related to components in Lear et al. in order to arrive at the claimed invention. This is a hindsight reading of the references which is not permitted under U.S. law.

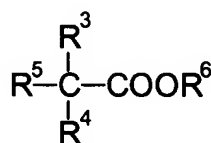
Moreover, even if the different components are combined in the manner suggested by the Examiner, the combination would not teach a component containing the carboxylic ester of formula (b) of the present invention. Thus, the combination of the teachings of Lear et al. and Mayer et al. would suggest a product quite different from the products of the present invention. Furthermore, Mayer et al. do not motivate one skilled in the art to combine its teachings with Lear et al. in order to make the necessary modifications to arrive at the claimed invention. Accordingly, Mayer et al. do not render the claimed invention obvious in view of Lear et al.

Because not each and every element of the claimed invention is either disclosed or suggested in Mayer et al. in view of Lear et al., the Examiner has failed to set forth a *prima facie* case of obviousness. In addition, because Mayer et al. do not motivate one skilled in the art to

combine its teachings with Lear et al. in order to make the necessary modifications to arrive at the claimed invention, the Examiner has failed to set forth a *prima facie* case of obviousness. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection under 35 U.S.C. §103(a).

The Examiner rejected claim 19 under 35 U.S.C. §103(a), alleging this claim is unpatentable over Lear et al. in view of Nanishi et al. Applicants respectfully traverse.

We reiterate the arguments of Lear et al. As discussed above, Lear et al. fail to disclose a resin composition comprising a polymer and a solvent, characterized in that said polymer is obtained by polymerizing (a) an acrylate monomer; (b) a tertiary carboxylic ester; and (c) a fluoro acrylate monomer. More specifically, Lear et al. do not disclose component (a) an acrylate monomer being combined with the tertiary carboxylic ester, as claimed. Moreover, Lear et al. do not disclose element (b) of claim 1, which is a tertiary carboxylic ester having the following general formula:



wherein R³, R⁴, R⁵ and R⁶ are as defined in claim 1. Lear et al. do not suggest or disclose making the necessary modifications in order to arrive at the resin composition of the claimed invention. Furthermore, Lear et al. do not motivate the skilled artisan to combine (a) an acrylate monomer; (b) a tertiary carboxylic ester; and (c) a monomer selected from the group consisting of a fluoro acrylate monomer, a silicone monomer, and a mixture thereof.

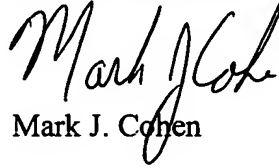
Nanishi et al. do not correct the deficiencies of Lear et al. Nanishi et al. disclose a

composition comprising a mixture of (a) a (co)polymer of 5 to 100% by weight of a specific fluoroalkyl group-containing (meth)acrylic monomer and 0 to 95% by weight of an unsaturated monomer co-polymerizable with the fluoroalkyl group-containing (meth)acrylic monomer, and (b) a copolymer of 0.1 to 75% by weight of a specific silicon-containing polymerizable unsaturated monomer and 25 to 99.9% by weight of an unsaturated monomer copolymerizable with the silicon-containing polymerizable unsaturated monomer, and fine silica particles having an average particle diameter of not more than 5 micrometers, in specified amounts. The combination of components in Nanishi et al. are not related to and are not the same as the components of the claimed invention. It suffers from the same deficiencies as Mayer et al., which are incorporated by reference. Furthermore, Nanishi et al. do not motivate one skilled in the art to combine its teachings with Lear et al. in order to make the necessary modifications to arrive at the claimed invention. Moreover, if these components were combined in a manner suggested by the Examiner, the combination would be quite different than the combination of the present invention. Accordingly, Nanishi et al. do not render the claimed invention obvious in view of Lear et al.

Because not each and every element of the claimed invention is either disclosed or suggested in Nanishi et al. in view of Lear et al., and because Nanishi et al. do not motivate one skilled in the art to combine its teachings with Lear et al. in order to make the necessary modifications to arrive at the claimed invention, the Examiner has failed to set forth a *prima facie* case of obviousness. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection under 35 U.S.C. §103(a).

Thus, in view of the foregoing amendments and remarks, the application is in condition for allowance, which action is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Mark J. Cohen". The signature is fluid and cursive, with the first name "Mark" being the most prominent.

Mark J. Cohen

Scully, Scott, Murphy & Presser
400 Garden City Plaza, Suite 300
Garden City, New York 11530
(516) 742-4343

MJC/RLB:ar